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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/255,277 02/23/99 YALE

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PM92/0102

EXAMINER
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CULBRETH, E

ART UNIT	PAPER NUMBER
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3611

DATE MAILED:

01/02/01

5

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/255,277**

Applicant(s)  
**Yale**

Examiner  
**Eric Culbreth**

Group Art Unit  
**3611**



☒ Responsive to communication(s) filed on Oct 16, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 11-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 11-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Oct 16, 2000 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

The declaration should include the wording above and refer to the applications being relied upon as parents by application serial number.

2. The drawings are objected to because:

- a. In Figures 1-3, the lead lines for reference numeral 1 should touch the part they refer to or have an arrow;

- b. Regarding page 8, lines 28 and 30 and the rest of the specification reference numeral 31 is not on the drawings (incidentally, if there are only two leaf springs disclosed, it is not clear why there are three reference numerals referring to them ("16, 24, and 31" at page 9, lines 28-30);

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c. The part labeled 47 in Figure 7 is labeled 22 or 27 in Figure 5, apparently; also note reference numeral 47 in Figure 8 (great confusion exists over the structure of the invention because of the misuse of reference numerals);

d. Contrary to page 17, lines 28-30 the bellows are not attached to the upper bracket by the lower plates. Correction is required.

3. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text. Noting applicant's amendment, filed 10/16/00, there is no page 20. The abstract should be resubmitted on a separate sheet of paper with applicant's next correspondence along with a request to substitute that attached abstract for the one currently in the case.

4. The disclosure is objected to because of the following informalities:

a. The Brief Description of the Drawings should follow the Summary of the Invention on page 3 (please note that the Office cannot move text or "reinsert" the Brief Description after the Summary; applicant will have to cancel the Brief Description and copy the text in a future amendment and instruct the Office as to the page and line number where it is to be inserted);

b. On page 13, lines 11 and 18-19 "preferably" is misspelled;

c. On page 13, line 13 a comma should follow "9";

d. On page 18, line 30 as amended "11" should apparently be "111";

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- e. On page 8, line 15 "29" should apparently be "17";
- f. On page 10, line 17 "29" should be "17".

Appropriate correction is required.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 11-30 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 5,873,581 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A bellows assembly with an adjustment means and orifice.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the removable orifice or restriction and separate fitting throughout the claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Also, the features of claims 20 and 30 must be illustrated without new matter.

9. The amendment filed 10/16/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure

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is as follows: There is no support for removable orifices or removable restrictions or separate fittings now listed throughout the claims. Also, there would not appear to be support for the orifices in the supply lines so that pressure to each bellows can be adjusted (claims 20 and 30).

Applicant is required to cancel the new matter in the reply to this Office action.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 11-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with lack of antecedent basis and double inclusion and other indefiniteness. Some examples are listed below.

In claims 11 and 21, there is no antecedent basis for “the bottom part”, “the lower movable part”, “the upper part”, “the upper movable part”, nor “the desired movement characteristics”.

Claims 12, 13, 22 and 23 should end with periods.

The governing orifice recited in claims 12, 13, 14, 22 and 23 and 24 is a double inclusion of the governing device already recited in independent claims 11 and 21.

In claims 16, 17, 26 and 27, “simple” is indefinite, failing to positively define structure.

In claims 20 and 30 there is no antecedent basis for “the rapid changes”.

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12.

Claims 13 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 11-13, 15-23 and 25-30 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribonic et al in view of Yamahara (both of record).

Pribonic et al discloses air bellows 34 between an upper frame 12 and a lower spring 22, as well as an air supply line 42 and adjustment means 38. However, Pribonic et al does not teach a governing orifice in the line to produce a time delay. Yamahara discloses an orifice 21 in a supply line to gradually discharge air (column 3, lines 1-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pribonic et al to include an orifice as taught by Yamahara in order to gradually discharge air from the shock or spring (claims 11-13 and 21-23).

In response to applicant's argument that Yamahara is a complex height control system, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated



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into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yamahara teaches at the cited text above that it is desirable to have an orifice in a line to an air bag to gradually discharge air, and this is a teaching in the art to make the modification in the references.

As functionally recited in claims 15, 18 and 25 and 28, the orifice is removable (i.e., tubing is conventionally disassemblable, and any part can be "removed" given welding or sufficient force).

Regarding claims 16-17 and 26-27, in the combination Yamahara indicates schematically a "simple valve" device that is a restriction, with any part being "removable" as broadly and functionally recited, and tubing and orifices in them are conventionally annular.

As broadly recited in claims 19 and 29, in the combination Yamahara's orifice is located "near" each spring schematically (there being only one spring), and this would be a teaching to locate the orifice "near" each bellows in the combination as broadly recited.

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As the material in claims 20 and 30 regarding a restriction near each bellows of multiple bellows so that each bellows can be governed independently is new matter, the combination meets the positive limitations of the claims.

15. Claims 14 and 24 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribonic et al in view of Yamahara as applied to claims 11 and 21 above, and further in view of Whelan (of record).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pribonic et al and Yamahara above to include two air bellows such as Whelan's bellows 10, 11 in order to better cushion the load by using more springs or bellows.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be


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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Culbreth whose telephone number is (703) 308-0360.

ec

December 31, 2000

  
ERIC CULBRETH  
PRIMARY EXAMINER  
12/31/00